UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Milton S. Sales
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER
ALI, MOHAMMAD

ART UNIT	PAPER NUMBER
2166	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/071,590	MCINTYRE ET AL.
	Examiner	Art Unit	
	Mohammad Ali	2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _15 August 2005_.
2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-11 and 14-16_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) _1-11 and 14-16_ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   This communication is in response to the amendment filed on 01/31/05.

Claims 1-11, and 14-16 are pending in this Office Action.

101 and 112 2nd issues have been withdrawn. By amending the claims

applicant's overcome these issues.

Response to Arguments

2.   After further search and a thorough examination of the present application claims

1-11 and 14-16 remain rejected.

Applicants' arguments with respect to claims 1-11 and 14-16 have been

considered, but they are not deemed to be persuasive.

First, Applicant's argue that Houchin does not teach 'providing new non-image

information with respect to the digital images that is added to the existing information'.

In response to applicant's arguments, the Examiner respectfully submits that in

particular, Houchin teaches this limitation as, providing an image file structure to

supports a header, image data, non-image data and extension portions and said

extensions portions including extension data and an extension persistence value

selected to indicate if extension data is to be maintained "provide" as part of the image

file when modifications "added" have been made to the image data portions of the

image file (see col. 2, lines 1-8, Houchin). Further, an application must take to add

extension data to the hypothetical image file. The application starts at 30 and steps to

reading the number of extensions field 16 from the image file 10 at step 32 and

increments this value at step 34. If per decision block 36 the incremented value is 1,

the extension about to be added is the first extension to be added to the image file 10.

The application must determine the location in the file where the extension data will be

written per step 38 and then write the incremented number of extensions, the extension

#1 offset and the extension #1 data to the file per step 40. If the incremented value of

the number of extensions field is not one, then there are already extensions in this file.

The application can read the extension data 26 for the extensions already in the file into

a buffer in memory per step 42. The application can then determine the new offsets for

both the existing extensions and the new extensions, taking into account the space

required to store the extension offset for the new extension per step 44. The new

extension data is then added to the buffer in memory per step 46. Finally, the

incremented value of the number of extensions field, the buffer of extension data and

the extensions offsets are written to the file per step 48 (see col. 3, lines 36-58,

Houchin).

Second, Applicant's argue that Houchin does not teach 'providing new

information'.

In response to applicant's arguments, the Examiner respectfully submits that in

particular, Houchin teaches this limitation as, stated above.

Third, Applicant's argue that Houchin does not teach 'automatically updating of

the non-image information with the new information'.

In response to applicant's arguments against the references individually, one

cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Further, in response to applicant's arguments, the Examiner respectfully submits that in particular, Houchin teaches particular limitation as stated above. Houchin does not explicitly indicate claimed "automatically updating". Parks remedy such kinds such kinds deficiency by teaching automatically update the coded data, see col. 10, lines 3-6, Parks. It would have been obvious to one ordinary skill in the data processing at the time of the present invention to combine teachings of the cited references because automatically updating of Parks teaching would have allowed Houchin's system to merge of digitalized images with alphanumeric character strings in a data processing as suggested by Parks at col. 1, lines 12-13.

Fourth, Applicants argue that "Prima facie case of obviousness" have not been established.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine,* 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones,* 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to automatically updating of Parks by applying the teachings of Houchin as indicated

above, to enhance its performance. It would have been obvious to one ordinary skill in

the data processing at the time of the present invention to combine teachings of the

cited references because automatically updating of Parks teaching would have allowed

Houchin's system to merge of digitalized images with alphanumeric character strings in

a data processing as suggested by Parks at col. 1, lines 12-13.

In response to applicant's argument on page 8, *a prima facie case of*

obviousness is established when the teachings from the prior art itself would appear to

have suggested the claimed subject matter to a person of ordinary skill in the art. Once

such a case is established, it is incumbent upon appellant to go forward with objective

evidence of unobviousness. In re Fielder, 471 F.2d 640, 176 USPQ 300 (CCPA 1973).

Examiner is entitled to give claim limitations their broadest reasonable

interpretation in light of the specification.

Interpretation of Claims-Broadest Reasonable Interpretation

During patent examination, the pending claims must be 'given the broadest

reasonable interpretation consistent with the specification.' Applicant always has the

opportunity to amend the claims during prosecussion and broad interpretation by the

examiner reduces the possibility that the claim, once issued, will be interpreted more

broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).

Reference is made to MPEP 2144.01 - Implicit Disclosure

"[I]n considering the disclosure of a reference, it is proper to take into account not only
specific teachings of the reference but also the inferences which one skilled in the art
would reasonably be expected to draw therefrom." In re Preda, 401 F.2d 825, 826,
159 USPQ 342, 344 (CCPA 1968)
        Subsequent to an analysis of the claims it was revealed that a number of

limitations recited in the claims belong in the prior art and thus encompassed and/or

implicitly disclosed in the reference (s) applied and cited. It is logical for the examiner to

focus on the limitations that are "crux of the invention" and not involve a lot of energy

and time for the things that are not central to the invention, but peripheral. The examiner

is aware of the duties to address each and every element of claims, however, it is also

important that a person prosecuting a patent application before the Office or an

stakeholders of patent granting process make effort to understand the level of one of

ordinary skill in the (data processing) art or the level one of skilled in the (data

processing) art, as encompassed by the applied and cited references. The

administrative convenience derived from such a cooperation between the attorneys and

examiners benefits the Office as well the patentee.

In view of the above, the examiner contends that all limitations as recited in the

claims have been addressed in this Action.

For the above reasons, Examiner believed that rejection of the last Office action
was proper.

In response to applicant's argument, to combine the references, the examiner recognizes

that obviousness can only be established by combining or modifying the teachings of the prior

art to produce the claimed invention where there is some teaching, suggestion, or motivation to

do so found either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In

re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

"Test of obviousness is not whether features of secondary reference may be bodily

incorporated into primary reference's structure, nor whether claimed invention is expressly

suggested in any one or all of references; rather, <u>test is what combined teachings of references</u>

would have suggested to those of ordinary skill in art."

In re Keller, Terry, and Davies, 208 USPQ 871 (CCPA 1981).

"Reason, suggestion, or motivation to combine two or more prior art references in single

invention may come from references themselves, from knowledge of those skilled in art that

certain references or disclosures in references are known to be of interest in particular field, or

from nature of problem to be solved;" Pro-Mold and Tool Co. v. Great Lakes Plastics Inc. U.S.

Court of Appeals Federal Circuit 37 USPQ2d 1626 Decided February 7, 1996 Nos. 95-1171, -

1181

"[q]uestion is whether there is something in prior art as whole to suggest desirability, and thus

obviousness, of making combination." Lindemann Maschinenfabrik GMBH v. American Hoist

and Derrick Company et al. U.S. Court of Appeals Federal Circuit 221 USPQ 481 Decided Mar.

21, 1984 No 83-1178.

Fifth, Applicant's argue that Houchin does not teach 'image software application

running at the remote site'.

In response to applicant's arguments, the Examiner respectfully submits that in

particular, Houchin teaches this limitation as, electronic imaging stores as a digital

image and an extension technique that tells a software application whether extension

data should be maintained or deleted if baseline data image or non-image data is

modified by the application (see col. 1, lines 5-10, Houchin). Network performance has

been done for wasting disk space. Since network connection is exists it is obvious to run

software from the remote site (see col. 1, lines 50-51, Houchin)

Hence, Applicants' arguments do not distinguish over the claimed invention over the prior art of record.

In light of the foregoing arguments, the 103 rejections are hereby sustained.

Claim Rejections - 35 USC § 103

3.　　The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4.　　Claims 1-11, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houchin et al. ('Houchin' hereinafter), USP 5,983,229 in view of Parks et al. ('Parks' hereinafter), USP 5,025,396.

With respect to claim 1,

Houchin discloses a method for automatically updating non-image data stored at a first storage location using a first image application, said non-image data being associated with a digital image of a user (see col. 2, lines 18-26), comprising the steps of:

providing new information with respect to said digital image in a second image application same (see col. 1, lines 5-11); and

automatically updating said non-image data at said first storage location with respect to said information (see col. 2, lines 54-56, Fig. 1).

Houchin does not explicitly indicate claimed "automatically updating".

Parks discloses automatically updating (automatically update the coded data, see col. 10, lines 3-6, Parks).

It would have been obvious to one ordinary skill in the data processing at the time of the present invention to combine teachings of the cited references because automatically updating of Parks teaching would have allowed Houchin's system to merge of digitalized images with alphanumeric character strings in a data processing as suggested by Parts at col. 1, lines 12-13.

As to claim 2,

Houchin teaches wherein said second image application further comprises an application for the production of an image product (see col. 2, lines 18-26).

As to claim 3,

Houchin teaches wherein said second image application runs on a computer

which is associated with said first storage location (see col. 3, lines 36-39, Fig. 2 et

seq).

As to claim 4,

Houchin teaches wherein said non-image data and said digital image are stored

at said first storage location (see col. 3, lines 66-66, Fig. 3 et seq).

As to claim 5,

Houchin teaches wherein said non-image data is contained within said digital

image (see col. 3, lines 66-66, Fig. 3 et seq).

As to claim 6,

Houchin teaches wherein said provided information is used to update said non-

image data associated with a group of said digital images of a user (see col. 4, lines 10-

15, Fig. 3 et seq).

As to claim 7,

Houchin teaches wherein said group of said digital images comprises an album

page and said provided non-image information is provided with respect to a feature of

the album page (see col. 3, lines 66-66, Fig. 3 et seq).

With respect to claim 8,

Houchin discloses a method for automatically updating non-image data stored at

a first location, said information being associated with a digital image of a user (see col.

2, lines 18-26), comprising steps of:

providing at least one digital image of a user to a remote image server (see col. 1, lines 5-11);

said user granting access to at least one third party to said at least one digital image stored at said remote image server (see col. 1, lines 5-11 and Abstract);

said third party providing information with respect to said at least one digital image using an image application running at said remote site (see col. 1, lines 5-11); and

automatically updating said non-image data with said information (see col. 2, lines 54-56, Fig. 1).

Houchin does not explicitly indicate claimed "automatically updating".

Parks discloses automatically updating (automatically update the coded data, see col. 10, lines 3-6, Parks).

It would have been obvious to one ordinary skill in the data processing at the time of the present invention to combine teachings of the cited references because automatically updating of Parks teaching would have allowed Houchin's system to merge of digitalized images with alphanumeric character strings in a data processing as suggested by Parts at col. 1, lines 12-13.

As to claim 9,

Houchin teaches wherein the step of said third party providing information with respect to said at least one said digital image further comprises providing comments with respect to a photo album stored at said remote site (see col. 3, lines 66-66, Fig. 3 et seq).

With respect to claim 10,

Houchin discloses a method for updating non-image data stored at a first

location, said information being associated with a digital image of a user (see col. 2,

lines 18-26), comprising steps of:

providing at least one digital image of a user to a remote image server (see col.

1, lines 50-51 et seq);

said user granting access to at least one third party to said at least one digital

image stored at said remote image server (see col. 2, lines 63-67 et seq);

said third party providing information with respect to said at least one digital

image in an image application running at said remote image server (see col. 3, lines 66-

66 and Abstract, Fig. 3 et seq);

notifying said user of the existence of said information with respect to said at

least one digital image (see col. 3, lines 66-66, Fig. 3 et seq); and

automatically updating said non-image data with said information if said user

decides to do so (see col. 4, lines 10-15, Fig. 3 et seq).

Houchin does not explicitly indicate claimed "automatically updating".

Parks discloses automatically updating (automatically update the coded data,

see col. 10, lines 3-6, Parks).

It would have been obvious to one ordinary skill in the data processing at the

time of the present invention to combine teachings of the cited references because

automatically updating of Parks teaching would have allowed Houchin's system to

merge of digitalized images with alphanumeric character strings in a data processing as suggested by Parts at col. 1, lines 12-13.

With respect to claim 11,

Houchin discloses a method for updating non-image data associated with digital images of a user stored at a first storage location (see col. 2, lines 18-26), comprising the steps of:

granting access to said digital images stored at said first location to at least one third party (see col. 2, lines 63-67, Fig. 3 et seq);

transferring at least one of said digital images from said first storage location to said third party's computer over a communication network (see col. 1, lines 50-51 et seq);

said third party providing information with respect to said at least one digital image in an image application running on said third party's computer (see col. 1, lines 50-51 et seq);

notifying said user over said communication network of the existence of said information with respect to said at least one digital image (see col. 3, lines 66-66, Fig. 3 et seq); and

updating said non-image data stored at said first storage location with said information if said user decides to do so (see col. 4, lines 10-15, Fig. 3 et seq).

Houchin does not explicitly indicate claimed "automatically updating".

Parks discloses automatically updating (automatically update the coded data, see col. 10, lines 3-6, Parks).

It would have been obvious to one ordinary skill in the data processing at the

time of the present invention to combine teachings of the cited references because

automatically updating of Parks teaching would have allowed Houchin's system to

merge of digitalized images with alphanumeric character strings in a data processing as

suggested by Parts at col. 1, lines 12-13.

As to claim 14,

Houchin teaches wherein said computer is located remote from said first storage

location (see col. 4, lines 10-15, Fig. 3 et seq).

As to claim 15, Houchin teaches wherein said first storage location comprises a

computer of said user and said remote computer comprises that of a third party (see

col. 4, lines 10-15, Fig. 3 et seq).

Claim 16 has same subject matter as of claims 8 and 10 and essentially rejected

for the same reasons as discussed above.

Conclusion

5.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Contact Information

6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Mohammad Ali whose telephone number is (571) 272-

4105. The examiner can normally be reached on Monday-Thursday (7:30 am-6:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Hosain T. Alam can be reached on (571) 272-3978. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Mohammad Ali
Primary Examiner
Art Unit 2166

November 5, 2005